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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,819	09/21/2000	Stuart G. Pickard	MB1-112188-001	2327

7590

12/09/2003

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EXAMINER
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GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/668,819

Applicant(s)

PICKARD ET AL.

Examiner

Matthew s Gart

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-17 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 3625

### DETAILED ACTION

Claims 2 and 4 were canceled via Paper No. 11. Claims 16 and 17 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 5. Claims 1, 3 and 5-17 are pending in the instant application.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 3 and 5-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Shkedy U.S. Patent No. 6,260,024.**

Referring to claims 1 and 12-13. Shkedy discloses a method of transacting sales over a computerized network (at least Abstract), the method comprising the steps of:

- Defining a first product to be purchased by a first purchaser (at least column 5, lines 7-24);
- Calculating a first commitment price in response to historical sales performance of the first product and recorded vendor prices (at least Fig. 2A, Step 54);

Art Unit: 3625

- Enabling the first purchaser to search a product database for a pre-existing database record associated with a product having a relationship to the first product acceptable to the first purchaser (at least Fig. 5).
- Correlating in a first database record the first product and the first purchaser (at least column 5, lines 7-24);
- Further correlating in respective ones of a plurality of first database records the first product and respective ones of a plurality of second purchasers (Buyer database **255** maintains data on buyers with fields such as name, address, telephone number, credit card number, ID number, social security number, electronic mail address, smart card ID, credit history, public/private key information etc. Buyer database **255** also contains the tracking number of each FPO **100** generated by the buyer, and the tracking number of each pooled order **110** that comprises the buyer's FPOs 100.);
- Issuing an offer to a vendor to purchase the first product at a first offer price in a quantity responsive to the plurality of first database records (at least Fig. 7 and Fig. 8);
- Enabling a vendor of products having a predetermined similarity to the first product to search the product database (at least Fig. 7); and
- Consummating a transaction between the vendor and the first and second purchasers (at least column 3, lines 39-57).

Referring to claims 3 and 5-6. Shkedy discloses a method according to claim 2 as indicated supra. The method of calculating a first commitment price will not

Art Unit: 3625

distinguish the claimed invention from the prior art in terms of Patentability. These dependent claims are based on non-material functional language and therefore will be given little patentable weight. The method of calculating a first commitment price is not critical to the invention "A method of transacting sales over a computerized network," and could be calculated via numerous means.

Referring to claim 7. Shkedy further discloses a method wherein there are provided the steps of:

- Defining a second product desired to be purchased by a first purchaser;
- Calculating a second commitment price in response to historical sales performance of the second product and recorded vendor prices; and
- Correlating in the second database record the second product and the first purchaser (at least column 5, lines 25-30).

Referring to claim 8. Shkedy further discloses a method wherein there is further provided the step of correlating in respective ones of a plurality of second database records the second product and respective ones of a plurality of third purchasers (at least Fig. 1).

Referring to claim 9. Shkedy further discloses a method wherein there is further provided the step of issuing a offer to a vendor to purchase the second product at a second offer price in a quantity responsive to the plurality of second database records (at least column 15, lines 42-57).

Referring to claim 10. Shkedy further discloses a method wherein there is provided the step of formulating a first consolidated report for presentation to the first purchaser responsive to the first and second offer prices (at least Fig. 10, Step 1020).

Referring to claim 11. Shkedy further discloses a method wherein there is provided the step of formulating a first consolidated report for presentation to the first purchaser responsive to the first and second database records (at least Fig. 2).

Referring to claims 14. Shkedy further discloses a method wherein prior to performing said step of consummating a transaction there is provided the step of consummating a transaction between at least one vendor for a quantity of the first product responsive to a predetermined portion of the total number of first database records (at least Fig. 5).

Referring to claims 15. Shkedy further discloses a method wherein prior to performing said step of consummating a transaction there is provided the step of consummating a transaction between at least one vendor for a quantity of the first product responsive to the total number of first database records (at least Fig. 5).

### ***Response to Arguments***

Applicant's arguments filed 9/9/2003 have been fully considered but they are not persuasive.

The Attorney argues, "... The approach of the instant invention is presenting pricing information to the buyer is distinguishable from that of the Shkedy '024 reference which is not concerned with presentation of the pricing that historically can be achieved by the system."

Art Unit: 3625

The Examiner notes Shkedy does disclose an example of a commerce system where the seller does not set a fixed, non-negotiable price. However, the seller still exercises a certain amount of control as he can set a minimum bid or offer the goods subject to a reserve. This reserve would have to be based on some knowledge of the market in order to operate efficiently. Knowledge of a market is typically achieved through many factors including historic research. (Shkedy: column 1, lines 46-55)

Furthermore, Shkedy admits, the problem with an auction is that the buyer is accepting all the risk in determining a fair price for the goods and services he requires. If he provides a low bid, no seller would choose to bind his contract. On the other hand, if he overbids, sellers would jump at the opportunity to enter into a binding contract with him. Also, if he overspecifies the conditions of his offer, he may never be able to find a seller willing to offer him the goods (Shkedy: column 2, lines 10-24). Therefore it is apparent that Shkedy is concerned with pricing presentation.

The Attorney argues, the methodology by which a first commitment price is determined is a proper component of the overall process for transacting sales over a computerized network, and will be significant in determining the commercial success of the system.

The Examiner notes, the method of calculating a first commitment price will not distinguish the claimed invention from the prior art in terms of Patentability. These dependent claims are based on non-material functional language and therefore will be given little patentable weight. Data identifying a specific calculation type is not functionally related to the substrate of the method. Thus, this descriptive material will

Art Unit: 3625

not distinguish the claimed invention from the prior art in terms of patentability, see *Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

The Attorney disagrees with the Examiner's use of the content of the preamble of the claim as a mechanism for minimizing the patentability of specifically recited structural or method elements.

In response to applicant's arguments, A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The Attorney argues that Shkedy does not disclose a first consolidated report for presentation to the first purchaser responsive to the first and second offer prices.

The Examiner notes, Shkedy does disclose an example of a pooling process performed by an intermediary. Suppose buyer A wishes to purchase two dozen BIC medium point black roller ball pens for a maximum price of \$5.00 per dozen and buyer B wishes to purchase one dozen BIC medium point black roller ball pens for \$5.00 per dozen, one dozen BIC medium point blue roller ball pens for \$4.00 per dozen and one dozen pencils at \$2.00 per dozen. The pooling or aggregation process adds the two FPOs to form a combined PPO 110 of three dozen BIC medium point black roller ball



Art Unit: 3625

pens at \$5.00 per dozen, one dozen BIC medium point blue roller ball pens at \$4.00 per dozen and one dozen pencils at \$2.00 per dozen.

The items of the FPO are extracted and are then posted to the PPO database. The PPO database contains a record for each PPO and a record for each item in the PPO. The PPO record contains fields such as status, tracking number, time-stamp, pool date and category. The status field has values of pending, active, expired and completed. A pending status means that the PPO cannot currently be bid on by a seller (Shkedy: column 15, line 25 to column 16, line 6).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

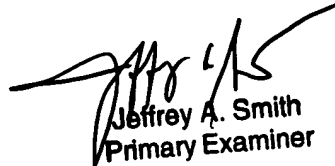
Art Unit: 3625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG

December 1, 2003



Jeffrey A. Smith  
Primary Examiner